

***THIS OPINION WAS NOT WRITTEN FOR PUBLICATION***

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 17

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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***Ex parte*** EDWARD J. TOWNS

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Appeal No. 96-0619  
Application 08/075,409<sup>1</sup>

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ON BRIEF

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Before MEISTER, FRANKFORT and McQUADE, ***Administrative Patent Judges.***

MEISTER, ***Administrative Patent Judge.***

***DECISION ON APPEAL***

This is an appeal from the final rejection of claims 1-12. Claims 13 and 14, the only other claims present in the application stand withdrawn from further consideration by the

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<sup>1</sup> Application for patent filed June 14, 1993.

examiner under the provisions of 37 CFR § 1.142(b) as being directed to a nonelected species.<sup>2</sup>

The appellant's invention pertains to a resinous container and a closure cap therefore.

Independent claim 1 is further illustrative of the appealed subject matter, a copy of which may be found in the appendix to the appellant's brief.

The reference relied on by the examiner is:

Ochs	5,062,538	Nov. 5, 1991
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Claims 1-12 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Ochs. It is the examiner's position that:

Ochs teaches a package with a pressure venting closure comprising a container 10 with a neck finish 12, and opening 41, a frustoconical sealing surface 15, a thread 11, and an annular engagement bead (not numbered), and a closure 32 with an end wall 30, 33, a side wall 26, 43, a frustoconical sealing area 39, a thread 28, means for venting 56, a tamper indicating band (annular retaining bead) 32, 58, and a domed inner surface 34. [Answer, page 3.]

In support of this position the answer also states that:

In response to Appellant's arguments directed to the reference of Ochs not teaching a closure with an end wall and a cylindrical side wall integrally formed therewith, the examiner submits the following case law.

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<sup>2</sup> In the first Office action (Paper No. 7) the examiner required an election of species between: "Species 1 of figures 1-3, Species 2 of figures 4-6, and Species 3 of figures 7-9" (see page 2). In response to this requirement the appellant in Paper No. 8 elected the "species 2 shown in Figures 4 to 6, inclusive," further stating that claims 1-12 were readable on this species. We observe, however, that independent claims 1 and 11 (the only independent claims in the application) are only readable on the species of Figs. 1-3.

The term “integral” means something different from “one-piece,” and includes both homogenous and separate but joined elements, and [the] broadest reasonable interpretation of “integral” includes components separate initially, but later joined together. *In re Miskinyar*, [6 F.3d 787,] 28 USPQ2d 1789 (CFAC [sic, Fed. Cir.] 1993).<sup>3</sup>

Since the closure of Ochs is formed from two pieces 24, 25 which are permanently retained together by the upper portion of threads 28, the closure is therefore “integrally” formed. [Page 4; footnote added.]

We will not support the examiner’s position. A prior art reference anticipates the subject matter of a claim when that reference discloses each and every element set forth in the claim (*see In re Paulsen*, 30 F.3d 1475, 1478-79, 31 USPQ2d 1671, 1673 (Fed. Cir. 1994) and *In re Spada*, 911 F.2d 705, 708, 15 USPQ2d 1655, 1657 (Fed. Cir. 1990)). Here, we find nothing in Ochs which teaches a closure with an end wall and a generally cylindrical side wall formed integrally therewith as expressly required by independent claims 1 and 11.

The examiner considers the members 24, 25 of Ochs to correspond to the claimed closure. We must point out, however, that the members 24, 25 of Ochs collectively form a “composite closure 20” (see the sentence bridging columns 4 and 5). That is, the member 25 of Ochs (the center portion 33 of which the examiner construes as forming part of the claimed end wall) is an “insert disk” that is an *entirely separate element* from the shell 24 (which includes a

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<sup>3</sup> The examiner’s reliance upon this decision as “case law” is inappropriate inasmuch as it is an *unpublished* decision.

cylindrical side wall 26 and a top lip 30 that are of a one-piece construction). The examiner apparently recognizes this, but notes that “integral” is broad enough to encompass separate elements which are joined or fastened together. Thereafter, the examiner takes the position that the insert disk 25 of Ochs can be considered to be “integrally formed” with the shell 24 because the shell clamps the insert disk to the mouth of Ochs’ container when closure is effected and accordingly are “joined together” and, hence, “integral.”

While it is well settled that “‘integral’ is sufficiently broad to embrace constructions united by such means as fastening and welding,” *In re Hotte*, 475 F.2d 644, 647, 177 USPQ 326, 329 (CCPA 1973), the insert disk 25 and shell 24 (which together form the composite closure 20 of Ochs) cannot be fairly construed to be “united” within the meaning of *Hotte*. That is, even though the shell 24 of Ochs is screwed onto the finish of the container the lip 30 so as to **clamp** the insert disk 25 to the mouth of the container, when the shell 24 is unscrewed and removed from the container, the insert disk remains behind as a separate element. In short, the insert disk 25 and shell 24 of Ochs are never secured together in such a manner that they form a “single unit” or constitute a “unitary whole.” *In re Larson*, 340 F.2d 965, 144 USPQ 347, 349 (CCPA 1965).

Since the end wall of Ochs cannot be fairly construed as being “formed integrally” with the generally cylindrical side wall as expressly required by independent claims 1 and 11, we will not sustain the rejection of claims 1-12 under 35 U.S.C. § 102(b) based on this reference.

Under the provisions of 37 CFR § 1.196(b) we make the following new rejection.

Claims 9 and 10 are rejected under 35 U.S.C. § 112, first paragraph, as being based on a non-enabling disclosure. We initially observe that the test regarding enablement is whether the disclosure, as filed, is sufficiently complete to enable one of ordinary skill in the art to make and use the claimed invention without undue experimentation. *See In re Scarbrough*, 500 F.2d 560, 566, 182 USPQ 298, 302 (CCPA 1974) and *In re Wands*, 858 F.2d 731, 737 8 USPQ2d 1400, 1404 (Fed. Cir. 1988). The appellant’s disclosure fails to teach how to make and use an embodiment having threads as set forth in dependent claim 9 and a tamper ring as set forth in dependent claim 10, while at the same time having (1) an annular bead on the closure and (2) venting means operative upon the opening of the container as set forth in parent claim 1. The only embodiment disclosed as having (1) an annular bead on the closure and (2) venting means operative upon the opening of the container is the embodiment of Figs. 1-3. On the other hand, the only embodiment disclosed as having mating both threads and a tamper ring indicating means is the embodiment of Figs. 4-6.

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In summary:

The rejection of claims 1-12 under 35 U.S.C. § 102(b) as being anticipated by Ochs is reversed.

A new rejection of claims 9 and 10 under 35 U.S.C. § 112, first paragraph, is made.

This decision contains a new ground of rejection pursuant to 37 CFR § 1.196(b)(amended effective Dec. 1, 1997, by final rule notice, 62 Fed. Reg. 53,131, 53,197 (Oct. 10, 1997), 1203 Off. Gaz. Pat. & Trademark Office 63, 122 (Oct. 21, 1997)). 37 CFR § 1.196(b) provides that, “A new ground of rejection shall not be considered final for purposes of judicial review.”

37 CFR § 1.196(b) also provides that the appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of proceedings (§ 1.197(c)) as to the rejected claims:

(1) Submit an appropriate amendment of the claims so rejected or a showing of facts relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the application will be remanded to the examiner. . . .

(2) Request that the application be reheard under § 1.197(b) by the Board of Patent Appeals and Interferences upon the same record. . . .

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No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

**REVERSED**  
**37 CFR § 1.196(b)**

JAMES M. MEISTER  
Administrative Patent Judge

CHARLES E. FRANKFORT  
Administrative Patent Judge

JOHN P. McQUADE  
Administrative Patent Judge

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Appeal No. 96-0619  
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***APPENDIX***

1. In combination, a synthetic resinous container and closure cap therefore particularly suited for storing liquid contents under pressure; said container having a principal longitudinal axis including a neck finish having an upper portion with an inner surface defining an opening, and an outer surface, said outer surface surrounding said opening and being of frustoconical configuration forming a sealing area, a medially disposed portion on said outer surface defining a closure retaining means: said closure being of flexible semi-rigid material and including an end wall and a generally cylindrical side wall formed integrally therewith; said side wall defining a frustoconical sealing area on an inner surface thereof corresponding to said sealing surface on said container finish adjacent said end wall; and means in the form of an annular bead on said side wall selectively engaging said closure retaining means to maintain said closure upon said finish; said means being distally positioned relative to said end wall, and having venting means operative upon the opening of said container.